patent Interference Nos. 104,283 and 104,284 was discussed. In that case, a five member panel of the Board of Patent Appeals and Interferences (which included Judge Lee) set forth a new practice regarding motions for adding reissue applications to an interference. This new practice is expressed in Section III-B of the decision as follows:

> "In light of the discussion in part IIIA, supra, we today announce the following practice. In the future, we will dismiss any preliminary motion under Rule 633(h) which seeks to add a reissue application to an interference when the reissue application contains non-original patent claims which the reissue applicant does not seek to have designated as corresponding to a count. Our newly announced practice does not preclude a patentee in an interference from filing a reissue application. If the reissue application contains new claims which the reissue applicant does not seek to have designated as corresponding to the count, the reissue application will not be added to the interference."

Inasmuch as the present reissue application contains new claims 30-40 and 42 which the applicant (Party Hill in Interference No. 104,331) has argued do not correspond to the count in the interference, the applicant requested a telephone conference in Interference No. 104,331 to discuss the effect of the Winter decision on Hill's motions 4 and 8. These motions seek to add the present reissue application to the interference and to claim the benefit of priority in the reissue application to the earlier Hill USP 5,104,209.

During the telephone conference, Judge Lee advised the applicant that Hill's motions 4 and 8 would be dismissed under the holding of the Winter decision because of the presence of new claims 30-40 and 42 which Party Hill has argued do not

correspond to the interference count. However, Judge Lee also indicated that an amendment could be filed in the present reissue application cancelling these new claims 30-40 and 42 to avoid dismissal of the Hill motions 4 and 8. Judge Lee further noted that the filing of such amendment should not subject claims 30-40 and 42 to interference estoppel if these claims are re-introduced in this or another reissue application in the future since these claims clearly cannot be considered in Interference 104,331 in light of the Winter decision.

In light of the above comments, entry of the present amendment is respectfully requested.

It is noted that a copy of this amendment will be filed in Interference No. 104,331.

Receipt is also acknowledged of an Office Action dated December 17, 1999 in this reissue application. Appreciation is expressed to the Examiner for the indication of the allowability of claims 1-41 over the prior art of record if the 35 USC 251 rejection regarding a defective reissue declaration is overcome. It is noted that the present amendment is not intended to be responsive to the December 17, 1999 Office Action. However, a response to the Office Action is being prepared and will be filed within the statutory period of response.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit

account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (312.104331R00), and please credit any excess fees to said deposit account.

Respectfully submitted,

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